

REMARKS

Claims 1-8, 39-58 are currently pending in the subject application and are presently under consideration. Claims 51 and 52 have been amended herein to correct minor informalities. A version of the claims showing changes made can be found at pages 2-8 of this Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

II. Rejection of Claims 1-8, and 39-58 Under 35 U.S.C. §103(a)

Claims 1-8, and 39-58 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kim-E (US 7,165,045, hereinafter referred to as “Kim”). Withdrawal of this rejection is respectfully requested for at least the following reasons. Kim fails to teach or suggest all the features set forth in the subject claims

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. In addition, there must be a reasonable expectation of success to make the proposed combination. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) *citing In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

The claimed subject matter relates in part to a multiple criterion buying and selling model that can correlate criteria defined by a buyer with the criteria defined by the sellers. The model can allow certain selling/buying criteria to be pre-selected prior to negotiating (e.g., price, quality, warranty). The model can also allow the buyer or seller to enter offering/ordering criteria, which can be a value or range for the selling/buying criteria (see e.g., 8, line 27 – pg. 9, line 4; FIGS 4a-b). Thus, rather than waiting for sellers to determine if they can meet all buying criteria, deals that match in terms of

offering/ordering criteria can be output in real time based upon the input criteria. In addition, sellers can be informed of buying criteria that does not match their own seller criteria. For example, the sellers of a particular good or service can define a set of minimum inputs and other criteria such as quality ratings of the goods (*see* page 11, lines 4-7; page 16, lines 15-21; Fig. 8b, element 303), while the buyers can enter criteria that is important to them such as warranty, of which the sellers may not have listed in their own criteria, or even be aware it would be of interest to buyers (*see* page 2, lines 24-25). Hence, the model can inform sellers of buyers' input criteria that the sellers did not list as their own criteria (*see* page 11, lines 13-15), and output deals in real time based upon the same or other criteria. In particular independent claim 1 (and similarly independent claims 40, 47, 50, 51, 52) recites, "notifying the seller of the particular product or service when the ***buying criteria*** does not match the ***seller criteria***." Kim does not teach or suggest these features.

Kim relates to an architecture to permit individual investors to participate in the bond market in a cost effective manner. (*See Abstract*). In particular, Kim discloses a system and method for facilitating securities trading wherein common investment desires of multiple customers can be pooled to purchase a quantity of a financial instrument in a single trade. (*See* col. 7, ll. 14-18). More particularly, Kim also provides for customer-to-customer (C2C) trades that do not require an intermediate broker to effect the transaction. (*See* col. 8, ll. 19-23).

While Kim teaches that, during C2C trades, when there is a discrepancy between terms of the trade ticket form, then the buyer and seller can be notified of the discrepancy. (*See* col. 21, ll. 39-40; FIG. 11, steps 840-844; *see also* col. 8, ll. 62-62; FIG. 4, elements 172-174). It is readily apparent that the terms of the trade ticket form are materially distinct from buyer/seller criteria of the subject claims. Accordingly, Kim does not teach the act of "notifying the seller of the particular product or service when the ***buying criteria*** does not match the ***seller criteria***."

Rather, Kim discloses that the trade ticket can include a customer ID and a "customer risk rating" or "CRR" (*see* col. 13, ll. 39-40), but is otherwise vague as to what might be included in the trade ticket and utterly void of any description of what a "term" of the trade ticket is. Regardless, even if these aspects are considered terms of the trade

ticket, then such terms (e.g., customer ID and CRR) are not buyer/seller criteria of the subject claims given that customer's are anonymous (see col. 19, ll. 13-15), so identity cannot constitute buyer/seller criteria in the context of Kim; and CRR likewise cannot be buyer/seller criteria in the context of Kim because CRR is expressly taught to remain private from other customers (see col. 7, ll. 11-13) and, given the obvious consequences of doing such, to share such private information would be antithetical to successful market/business practices. In addition, Kim teaches that the goal of direct communication between buyer and seller during C2C trading is to negotiate price. (See col. 21, ll. 29-31). Therefore, it might be suggested that price is a term of the trading ticket, and thus, when the price "terms" do not match, the buyer and seller are advised of the discrepancy. However, even assuming that price is a term of the trade ticket, such is, again, not buyer/seller criteria of the instant claims, as further detailed *infra*.

In essence, while Kim does not describe the nature of trade ticket terms, it is exceedingly clear that whatever these terms might be, they cannot be buyer/seller criteria of the subject claims. Most particularly, the trade ticket is provided to the buyer and seller to complete only during C2C trading and only *after* price is agreed upon during direct, albeit anonymous, negotiation between a buyer and a seller. (See col. 21, ll. 32-35; *see also* col. 8, ll. 58-61). Accordingly, in order to support this rejection, the Examiner must show that advising the seller as to a discrepancy in the trade ticket terms as taught by Kim is identical to the claimed act of notifying the seller when "the buying criteria does not match the seller criteria." Such a conclusion is not supported by any portion of the reference, especially given that customer ID and CRR (possible terms of the trade ticket) in the context of Kim are clearly dissimilar to buyer/seller criteria as claimed. Moreover, however unlikely it might be in the context of the reference, even if price is considered a term of the trade ticket, price is again not relevant to the claimed subject matter in the context of Kim because Kim teaches that this "term" is input *after* price is agreed upon.

As such, price, or any possible element disclosed by Kim cannot constitute buyer/seller criteria of the claimed subject matter since such a term is only input after price is agreed upon during direct negotiation. For example, since the claims also recite features relating to correlating the deals based upon the *criteria* and outputting a list of

deals that match the *criteria*, these recited acts cannot be disclosed by Kim if the Examiner considers terms of the trade ticket to be analogous to buyer/seller criteria, as such terms are entered *after* negotiation. That is, the claims must be considered as a whole, not rejected in a piecemeal fashion with simultaneously alternative definitions for claimed features. If the Examiner suggests terms of the trade ticket are the buyer/seller criteria of the claims, then this analysis fails because Kim does not then teach using the terms of the trade ticket in connection with the claimed acts of (1) correlating deals; and (2) outputting deals that match. In fact, no correlating of deals takes place during C2C trading, but rather, what is provided is merely a listing of all bonds for sale, irrespective of the buyer's buying criteria, and so it is up to the buyer to select the appropriate bond. (See FIG. 10, element 704). Likewise, no list of deals is output that "match the buying criteria of the buyer."

If, on the other hand, the Examiner looks to other portions of the reference to teach these claimed acts (e.g., portions not related to C2C trading), such portions are unrelated to trade tickets so there cannot be a discrepancy to report to sellers. In either case, assuming *arguendo* that Kim teaches the claimed acts of correlating and outputting in other contexts (which is neither argued nor supported by the Examiner's analysis), then whatever criteria are employed to perform these acts are necessarily materially distinct from the terms of the trading ticket that are employed to advise of discrepancies. In contrast, the subject claims delineate a single set of criteria for each of the buyer and the seller that is consistently employed for the aforementioned claimed acts. Accordingly, the Examiner has failed to make a *prima facie* case for obviousness and this rejection should be withdrawn.

In addition, the instant claims further recite, "the non-price criteria including at least one distribution criterion". At page 2 of the Office Action (mailed July 17, 2007) the Examiner concedes that Kim does not disclose these features but takes Official Notice that distribution criteria has been common knowledge in the electronic marketing art. Applicants respectfully traverse the aforementioned Official Notice and request that the Examiner cite a reference in support of this position pursuant to MPEP 2144.03 if this rejection is to be maintained. Furthermore, the indicated Official Notice appears to have no adequate relationship to the subject claims and is therefore moot. In particular, even

assuming that the Examiner's assertions are capable of instant and unquestionable demonstration as being well-known, asserting that a particular feature is well-known outside the context of and without the recited and inherent relationships of the all that is claimed is not adequate for a showing of obviousness. Hence, assuming as fact that distribution criteria has been common knowledge in the electronic marketing art does not necessarily imply that well-known distribution criteria is or could be reasonably considered to be the non-price criteria of the subject claims. Moreover, there does not appear to be any rational underpinning to support combining such distribution criteria (even if well-known) with a system for trading bonds online as taught by Kim.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [GEDP106US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,
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